

**REMARKS**

Claims 1-8 are pending in this application. By this Amendment, claims 1 and 8 are amended. Support for amended claims 1 and 8 may be found in the originally filed disclosure, e.g., at page 4, lines 5-6, and page 5, lines 8-10. No new matter is added. Claims 1 and 8 are the independent claims.

Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

**Claim Rejections - 35 U.S.C. § 103**

Claims 1-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,248,515 ("Gormon") in view of DE 29605891 ("DE '891"), and further in view of U.S. Patent No. 6,086,970 ("Ren"). Applicants respectfully traverse this rejection for the reasons discussed below.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), all of the claim limitations of the rejected claims must be described or suggested by the cited document(s).<sup>1</sup> Applicants respectfully submit that the cited documents do not meet this criterion, because no combination and/or modification of the Gormon, the DE '891, and the Ren references will describe or suggest all of the claim limitations of rejected claims 1-8, and therefore, a *prima facie* case of obviousness has not been established.

For example, claim 1, as amended, recites, *inter alia*:

the inner layer region and the outer layer region are formed by a wire guide **coextrusion** process so as to be integrally bonded to each other. (*emphasis added*)

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<sup>1</sup> See *In Re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See also MPEP § 2143.03.

Applicants respectfully submit that none of the applied references disclose or suggest the above feature.

In the outstanding Office Action, the rejection is based on an assertion that the liner 14 of Gormon corresponds to “an inner layer” and the casing 16 of Gormon corresponds to “an outer layer.” *See Office action mailed July 30, 2009, page 2, paragraph 2a.* Applicants respectfully submit, however, that the liner 14 and the casing 16 of Gormon are not “layers” since the liner 14 and casing 16 are two separate components or parts. In other words, there is not a structure composed of layers in Gormon.

Notwithstanding the above, Applicants submit that the liner 14 and casing 16 of Gormon are not formed by a wire guide *coextrusion* process.

Instead, the Gormon reference discloses:

the conduit 10 also comprises an outer casing 16 having the liner 14 secured therein, with the outer surface of the liner 14 in contact with the inner surface of the casing 16 for increased liner support, and preferably secured together over a substantial part of their common area by a suitable adhesive such as glue.<sup>2</sup> (*emphasis added*)

Therefore, as discussed above, the outer casing 16 and the liner 14 are secured together by an adhesive member, e.g., glue, rather than being formed by a **coextrusion** process, as taught by claim 1. One skilled in the art would appreciate that a co-extruded blended inner layer region (e.g., a particulate additive of at least polytetrafluoroethylene) and an outer layer region being not blended with the additive would provide a sufficiently stiff reinforcing outer layer and provide sufficient stiffness required for the wire guide (i.e., the wire guide must have quite good stiffness to prevent the wire guide from bending into an excessively small radius), and the blended

inner layer provides a sufficient guiding factor. *See, e.g., page 3, lines 19-31 and page 4, lines 14-19 of the originally filed disclosure.*

Moreover, Applicants direct the Examiner to MPEP 2173.05(g), which states that a claim limitation used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step must be considered and evaluated.

Accordingly, Applicants respectfully submit that the Gormon reference fails to disclose, or even suggest, “the inner layer region and the outer layer region are formed by a wire guide coextrusion process so as to be integrally bonded to each other,” as recited in amended claim 1.

In regard to the DE ‘981 reference and the Ren reference, these references fail to provide the teachings noted above as missing from the Gormon reference. For instance, the DE’981 reference only discloses a plastic guide hose for welding wire or cable cores, and the Ren reference only discloses blending **external** lubricating PTFE particles to the tube.

Since the rejection fails to disclose or suggest each and every element of the rejected claims, Applicants respectfully submit that no *prima facie* case of obviousness has been established with respect to claim 1.

Further, in order to establish a *prima facie* case of obviousness, the Examiner must establish that it would have been obvious for one of ordinary skill to have combined the teachings of the cited documents.<sup>3</sup> One way to establish this would be to show “some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness” and “identify a reason that would have prompted a

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<sup>2</sup> See Gormon, col. 4, lines 67-72.

<sup>3</sup> See *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. at 398, 82 USPQ2d at 1396 (2007).

person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.”<sup>4</sup> Furthermore, the Examiner must make “*explicit*” this rationale of “the apparent reason to combine the known elements in the fashion claimed,” including a detailed explanation of “the effects of demands known to the design community or present in the marketplace” and “the background knowledge possessed by a person having ordinary skill in the art.”<sup>5</sup>

It is respectfully submitted that the Examiner has not met these criteria. For example, the Examiner asserts that:

it would have been obvious to a person of ordinary skill in the art at the time of the invention to form the inner plastic tubing layer of Gormon by blending lubricating PTFE particles because doing so would reduce feeding resistance (DE ‘891 –abstract) and provide an enhanced lubricity and collapse strength to the guide tube (Ren – abstract; col. 4, lines 45-52).<sup>6</sup>

However, it is respectfully submitted that the above statement is merely conclusory and do not comprise an “*explicit rationale*” as required by *KSR Int’l*. Therefore, because the Examiner has not provided an explicit analysis as required by *KSR Int’l*, a *prima facie* case of obviousness has not been established.

In view of the above, Applicants respectfully submit that the Gormon, the DE ‘891, and the Ren references, individually or in any combination, fail to teach or suggest each and every element of claim 1, and therefore, claim 1 is allowable over the cited prior art. Claim 8 is also allowable for the similar reasons discussed above regarding claim 1. Claims 2-7 are dependent from claim 1, and therefore, also allowable. Accordingly, Applicants respectfully requests that the rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

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<sup>4</sup> *Id.*

<sup>5</sup> *Id.*

<sup>6</sup> See Office action mailed July 30, 2009, page 3.

**Request for Interview**

Applicants respectfully request, prior to the issuance of an action on the merits, that the Examiner grant an interview with Applicants' representative in order to discuss the Office Action, and the differences between the cited prior art and the subject matter cited in the claims.

Applicants' representative will telephone the Examiner in the near future in an attempt to schedule this personal interview. However, as Applicants' representative cannot anticipate when this action will be scheduled for further action by the Examiner, it is requested that the Examiner contact Applicants' representative by telephone, at the number given below should a specific date for the interview have not been scheduled when the Examiner takes this action up for further action. Every effort will be made to meet the Examiner's scheduling preference.

**CONCLUSION**

In view of the above remarks and amendments, Applicants respectfully submit that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. Further, the above remarks demonstrate the failings of the outstanding rejections, and are sufficient to overcome the rejections. However, these remarks are not intended to, nor need they, comprehensively address each and every reason for the patentability of the claimed subject matter over the applied prior art. Accordingly, Applicants do not contend that the claims are patentable solely on the basis of the particular claim elements discussed above.

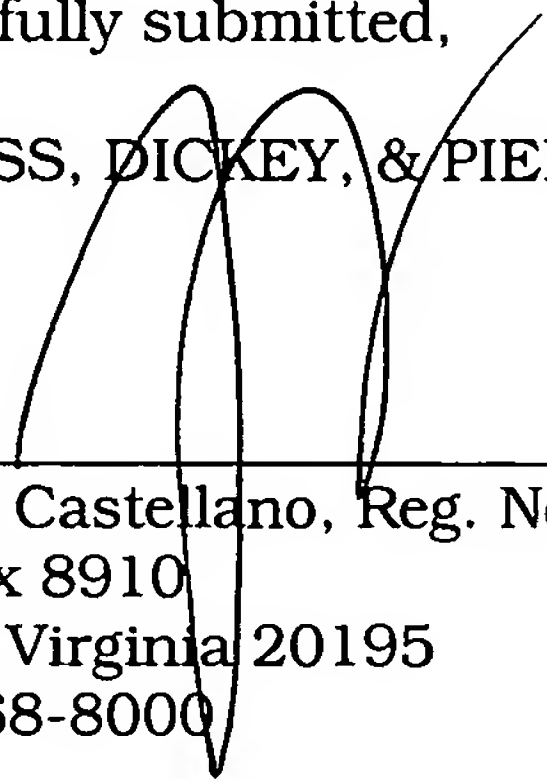
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKY, & PIERCE, P.L.C.

By



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